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Date: 6/26/06

By:

Patti Hespell  
Patti HespellMAIL STOP AFIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of Charles A. Eldering

Conf. No.: 8268 : Group Art Unit: 2623  
Appln. No.: 09/750,812 : Examiner: Manning, John  
Filing Date: December 28, 2000 : Attorney Docket No.: T733-10  
Title: Grouping Advertisement Subavails

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Applicant(s) request(s) review of the final rejection in the above-identified application, under the Pre-Appeal Brief Conference Program published on July 12, 2005. No amendments are being filed with this request.

- ☒ The review is requested for the reason(s) stated on the attached sheet(s).
- ☒ Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences is filed herewith.
- ☒ Extension of Time to and including July 6, 2006 is filed herewith.

Date:

6/26/06

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JUN 26 2006

Application No.:09/750,812

**STATEMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF CONFERENCE**

Presently, claims 18-34 are pending in the application. This paper is being filed in support of the Request for Pre-Appeal Brief Conference submitted herewith. Details of the Examiner's rejections may be found in the Final Office Action dated January 6, 2006 ("Final Office Action") and the Examiner's Advisory Action dated June 12, 2006 ("Advisory Action"). Discussion of the prior art references and the pending claims may be found in Applicants' Amendment filed September 7, 2005 ("Amendment") and Applicants' Response After Final Rejection filed May 2, 2006 ("Response After Final"), both of which are incorporated herein by reference.

***No Prima Facie Obviousness***

Even though the Examiner has not established a *prima facie* case of obviousness, the Examiner has not withdrawn the rejection of claims 18-19, 21, 27, 29, 31, 32 and 34 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,652,615 to Bryant *et al.* ("Bryant") in view of U.S. Patent Application No. 2002/0055880 to Unold *et al.* ("Unold"). The Examiner's reasons for this rejection may be found at pages 2-4 of the Final Rejection and are also summarized at page 2 of Applicants' Response After Final.

**1. There Is No Suggestion or Motivation to Modify the References**

The Examiner can satisfy the burden of *prima facie* obviousness only by showing an objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would lead that individual to combine the relevant teachings of the references in the manner suggested by the Examiner. *See In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1998). The mere fact that the prior art could be modified in the manner proposed by the Examiner, does not make the modification obvious unless the prior art suggests the desirability of the modification. *See Ex Parte Dussaud*, 7 USPQ2d 1818, 1820 (Bd. Pat. App. & Interf. 1988). *See* MPEP 2143.01(I).

Application No. 09/750,812

The Examiner has failed to point to an objective teaching in Bryant, Unold or in the knowledge generally available to one of ordinary skill in the art that suggests the desirability of combining these references. The Examiner has repeatedly contended that it would have been obvious to one of ordinary skill in the art to combine Bryant and Unold, but has failed to provide any support or explanation of this conclusion. The Examiner merely alleges that Unold "provides advertisers a convenient method of purchasing multiple advertisement opportunities" (Final Office Action, page 4; Advisory Action, page 2). Although the Examiner has provided a list of teachings from Unold's disclosure (Advisory Action, pages 2-3), such list does not provide an explanation as to why one of ordinary skill in the art would be motivated to utilize the teachings of Unold to modify Bryant, nor that one skilled in the art would recognize the advantages of doing so as alleged by the Examiner. Merely pointing out the existence of particular teachings in one reference is not sufficient to establish that there would be a motivation to combine that reference with another. The burden is on the Examiner to provide a convincing line of reasoning, based on knowledge generally available to one of ordinary skill in the art, established scientific principles or legal precedent, that there would have been a motivation to combine Bryant and Unold. *See* MPEP 2144.

## 2. The Proposed Combination Changes the Principle of Operation

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); MPEP § 2143.01.

Applicants have pointed out that the proposed combination of Bryant and Unold would change the principle of operation of Bryant's system. As explained at page 4 of Applicants' Response After Final, Bryant's system operates by selecting fill segments during distribution of the program. In Bryant, there is no guarantee that a particular fill segment will actually be inserted into the broadcast program, since the selection of a fill segment is based on, among other things, the "demographics of the network and customer premises equipment" (see Abstract of Bryant). In other words, if there are no viewers that match the intended

Application No. 09/750,812

demographic of a particular fill segment, then that particular fill segment will not be inserted into the broadcast program. In contrast, in Unold's system, the advertisement slots are selected by the advertisers in advance of program distribution; an advertiser knows, unconditionally and in advance, that each selected advertisement will be shown in its reserved advertising slot. Thus, the operations of the two systems are mutually incompatible. If Bryant were modified so that the fill segments were selected, in advance of distribution, to be shown unconditionally (as in Unold), then Bryant's principle of operation would have been changed, since it would no longer be possible for Bryant's system to select advertisements conditionally during distribution. Moreover, even though the Examiner has conceded that, in Bryant, "the fill segment is selected at the time of distribution" (Advisory Action, page 3), the Examiner refuses to acknowledge that Bryant's principle of operation would be changed by the proposed combination.

### 3. The Proposed Combination Does Not Teach or Suggest All Claim Elements

When making a rejection under 35 U.S.C. § 103, the prior art references, when combined, must teach or suggest all of the claim limitations. See MPEP 2143.03.

The combination of Bryant and Unold, even if proper, still does not teach or suggest all of the features of Applicants' claims. First, neither Bryant nor Unold teaches the expected viewership of an ad opportunity or subavail. The Examiner's argument at pages 3-4 of the Advisory Action, even if true, does not validate the Examiner's contention that Bryant and Unold teach that their respective systems account for the expected viewership of ad opportunities or subavails. The Examiner's general allegation that expected viewership is inherent in no way shows that either Bryant or Unold teach or suggest subavails that are "associated with a portion of the expected viewership of its corresponding advertisement opportunity," as recited in independent claim 18. Simply stated, neither Bryant nor Unold discusses expected viewership of subavails.

Applicants have repeatedly pointed out to the Examiner, both in written responses and during a personal interview, the clear distinction between a group of subavails taken from within a single advertising opportunity and a group of subavails aggregated from at least two (i.e.,

Application No. 09/750,812

multiple) advertising opportunities. The Examiner simply fails to acknowledge the corresponding claim language.

The Examiner's argument at page 4 of the Advisory Action pertains to subavails from within a single ad opportunity, and appears to be based on a principle of "the sum is equal to or greater than any of its parts." However, this argument is not relevant to Applicants' independent claim 18, which recites "aggregating the plurality of subavails from at least two of the advertising opportunities."

To help illustrate this feature, consider the example of Table 1, showing three separate ad opportunities (1, 2, 3), each divided into subavails. Each ad opportunity has a total expected viewership, of which each subavail for that ad opportunity has a part. For example, Ad Opportunity 1 has a total expected viewership of 20 and has been divided into four subavails (A, B, C, D), where subavail A has an expected viewership of 10. If a subavail group (denoted by the shaded cells in the table) is generated by aggregating, in this example, Subavail A from Ad Opportunity 1, Subavail B from Ad Opportunity 2, and Subavail C from Ad Opportunity 3, then the total expected viewership of the aggregated subavail group is 23, which is greater than the expected viewership of both Ad Opportunity 1 and Ad Opportunity 3. Thus, the total expected viewership of the subavail group is "greater than or equal to the expected viewership of one of the advertising opportunities from which the subavails in the at least one group originated," as recited in claim 18. The combination of Bryant and Unold does not teach or suggest this feature. A similar example could be formed using Fig. 2 of Applicants' specification by assigning expected viewerships to the avails and subavails therein.

	TOTAL	Subavail A	Subavail B	Subavail C	Subavail D	Subavail E
Ad Opportunity 1	20	10	3	2	5	N/A
Ad Opportunity 2	30	5	10	5	10	N/A
Ad Opportunity 3	15	1	4	3	5	2

Table 1 : Expected Viewership

Applicants respectfully submit that the combination of Bryant and Unold is improper since the Examiner has not pointed to an objective teaching which suggests the motivation to

Application No. 09/750,812

combine them and such a combination would require a fundamental change in operation of the primary reference. Even assuming the references were properly combinable, which they are not, all features of the claims would still not be taught by the combination. Therefore, the Examiner has not met the burden of *prima facie* obviousness. Accordingly, for the reasons detailed herein as well as in Applicants' Amendment and Response After Final, independent claims 18 and 29, and all claims dependent thereon, are allowable over the combination of Bryant and Unold.

***No Support for Official Notice***

The Examiner has refused to provide a relevant reference, as required by the MPEP, in support of the Official Notice (Final Office Action, page 11), which Applicants have adequately traversed (Response After Final, page 6). Applicants strenuously disagree with the Examiner's contention at page 4 of the Advisory Action that Applicants have not adequately traversed the Official Notice.

The burden is on the Examiner to produce a reference substantiating the Official Notice: "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known....If such notice is taken, the basis for such reasoning must be set forth explicitly" (MPEP 2144.03). Thus, the burden is not on Applicants to prove that the Official Notice is incorrect. Rather, the Examiner is required to produce a relevant reference that would support the Official Notice. Applicants have satisfied their burden of 2144.03 by indicating the errors in the Examiner's Official Notice: "There are 'facts beyond the record' which are 'capable of such instant and unquestionable demonstration as to defy dispute' as being 'well-known' in the art" (Response After Final, page 6). Applicants cannot prove the absence of common knowledge and simply guess at the Examiner's interpretation of what is common knowledge, nor are Applicants required to do so.

Applicants respectfully submit that the Examiner's rejections have been previously overcome, and that the application, including claims 18-34, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and a Notice of Allowance are respectfully requested.